IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Applicant:	§	
Jonathan Lowthert, et al.	§	Art Unit: 2623
	§	
Serial No.: 09/765,246	§	Examiner: Usha Raman
	§	
Filed: January 18, 2001	§	Atty Docket: BKA.0008US
	§	
For: Providing Content	§	
Interruptions	§	

Mail Stop **Appeal Brief-Patents**
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPEAL BRIEF

TABLE OF CONTENTS

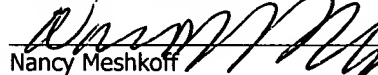## REAL PARTY IN INTEREST

The real party in interest is the assignee BlackArrow, Inc.

RELATED APPEALS AND INTERFERENCES

None.

STATUS OF CLAIMS

Claims 1-28 (Rejected).

Claim 29 (Canceled).

Claims 30-34 (Rejected).

Claims 1-28 and 30-34 are rejected and are the subject of this Appeal Brief.

STATUS OF AMENDMENTS

A Reply to Final Rejection was filed on July 10, 2007; however, no amendments were made in this reply. All amendments have therefore been entered.

SUMMARY OF CLAIMED SUBJECT MATTER

In the following discussion, the independent claims are read on one of many possible embodiments without limiting the claims:

1.   A method comprising:

allowing the use of content on a content receiver;

collecting information about one or more characteristics of the receiver (Fig. 4, 82) (Spec. at p. 15, lines 15-23);

providing the collected information to a remote processor-based system (Fig. 8, 84) (Spec. at p. 16, lines 13-25);

said receiver receiving, from the remote processor-based system, a first subset listing of advertising resources and guidelines for distributing advertising materials on the receiver, said first subset listing of advertising resources selected from a database of advertising resources based on at least one of said one or more characteristics of the receiver (Fig. 4, 86) (Spec. at p. 15, line 24 to page 16, line 4);

automatically and selectively choosing, on said receiver and without user intervention, an advertising resource from the first subset listing based on a given characteristic of the receiver to compile a second subset listing of advertising resources, the second subset listing finer tuned to a characteristic of the receiver than said first subset listing (Fig. 4, 90) (Spec. at p. 17, lines 5-20); and

capturing an advertisement listed on the second subset listing of advertising resources to store the advertisement on said content receiver (Fig. 4, 92) (Spec. at p. 17, lines 21-22).
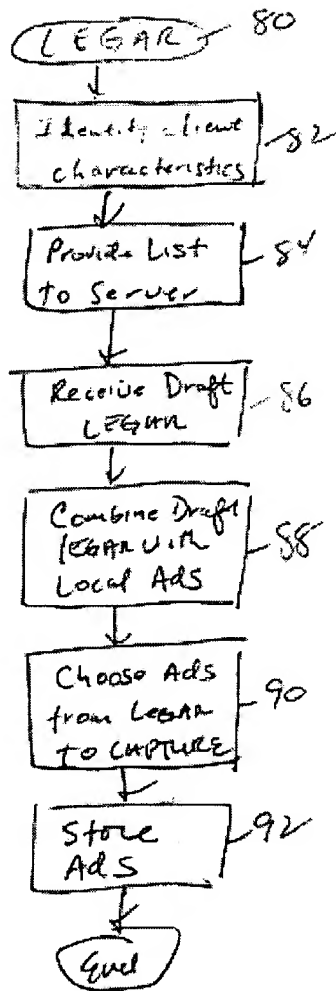
Figure 4

3. The method of claim 1 wherein collecting information includes monitoring the activities of the user of the receiver including monitoring the web sites that the user has visited and the application software that the user has utilized (Fig. 4, 82) (Spec. at p. 13, line 21 to p. 14, line 5).

11. An article comprising a medium for storing instructions that enable a receiver to:

allow the use of content on the receiver;

in response to detecting a pause in content usage, automatically interrupt the use of the content, the place in the content where the pause occurs, if said pause occurs at all, not predetermined;

while said content usage is paused, enable the receiver to temporarily replace the content with advertising;

collect information about characteristics of the receiver (Fig. 4, 82) (Spec. at p. 15, lines 15-23);

provide the information to a remote processor-based system (Fig. 4, 84) (Spec. at p. 16, lines 13-25);

receive, from said remote processor-based system, a subset listing of advertising resources and guidelines for using advertising materials in connection with the receiver, said subset listing selected from a database of advertising resources (Fig. 4, 86) (Spec. at p. 15, line 24 to p. 16, line 4);

selectively choose, without user intervention, an advertising resource from the subset listing based on a characteristic of the receiver (Fig. 4, 90) (Spec. at p. 17, lines 5-10); and

capture an advertisement corresponding to the chosen advertising resource to store the advertisement on said content receiver (Fig. 4, 92) (Spec. at p. 17, lines 21-22).

21.   A system comprising:

a receiver (Fig. 1, 16) that receives the transmission of content, said receiver including a shell (Fig. 1, 22) to enable the use of content to be paused and temporarily replaced with a previously stored advertising, said pause in the use of content initiated by a user at random (Spec. at p. 6, lines 6-19); and

storage (Fig. 1, 20) coupled to said receiver storing instructions that enable said receiver to determine information about a characteristic of the receiver, receive, from a remote processor-based system, a first subset listing of advertising resources and guidelines for distributing advertising materials on the receiver, the first subset listing based on the information about the receiver, use the information to automatically and selectively choose a subset of advertising resources from the first subset listing, and capture the advertisements corresponding to the subset of advertising resources to store the advertisements on the receiver (Spec. at p. 13, lines 7-20).
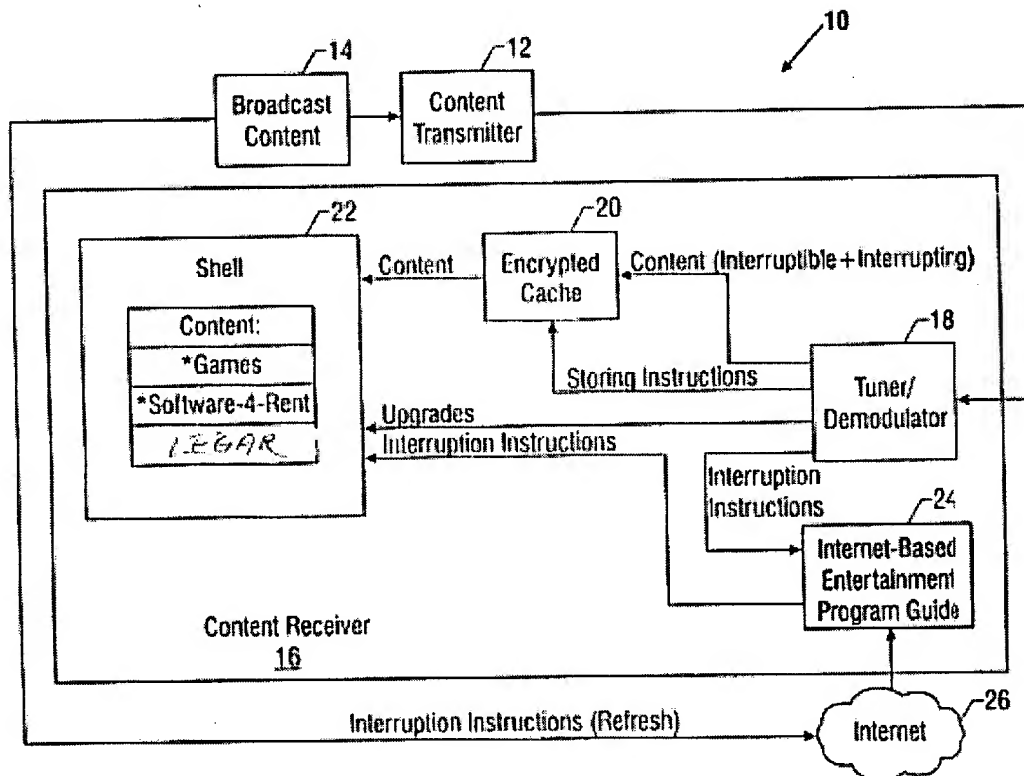
FIG. 1

33.   The method of claim 1 wherein collecting information includes collecting information about a characteristic of at least one of the hardware and software that is present on the receiver (Spec. at p. 13, line 21 to p. 14, line 5).

At this point, no issue has been raised that would suggest that the words in the claims have any meaning other than their ordinary meanings. Nothing in this section should be taken as an indication that any claim term has a meaning other than its ordinary meaning.

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

A.   Whether claims 1, 7-9, 11-28, and 30-32 are anticipated under 35 U.S.C. § 102(e) by Picco (US 6,029,045).

B.   Whether claims 2-6 and 10 are unpatentable under 35 U.S.C. § 103(a) over Picco (US 6,029,045).

C.   Whether claim 33 is unpatentable under 35 U.S.C. § 103(a) over Picco (US 6,029,045) in view of Moshfeghi (US 6,076,166).

D.   Whether claim 34 is unpatentable under 35 U.S.C. § 103(a) over Picco (US 6,029,045) in view of Thomas (US 2003/0037068).

ARGUMENT

A. A claims 1, 7-9, 11-28, and 30-32 are anticipated under 35 U.S.C. § 102(e) by Picco (US 6,029,045).

Claim 1 includes the following limitation among others:

> automatically and selectively choosing on said receiver without user
> intervention, an advertising resource from said first subset listing
> based on a given characteristic of the receiver to compile a second
> subset listing of advertising resources, and a second subset listing finer
> tuned to a characteristic of the receiver than the first subset listing.

It is suggested that Picco discloses that only select receivers matching the criteria of the distribution variable may download the local content. *See* bottom of page 3 of the Final Office Action. If this is so, there is no choosing *on the receiver* an advertising resource in the first set. There is no choosing, on the receiver, of any particular advertisement. Instead, the choice is done for the receiver by the uplink station.

Similarly, none of the material in paragraph 1 of the Office action provides any indication that any choosing is done by the local receiver.

Therefore the rejection should be reversed.

B. Whether claims 2-6 and 10 are unpatentable under 35 U.S.C. § 103(a) over Picco (US 6,029,045).

Claim 3 calls for the step of collecting information to include monitoring the activities of a user of the receiver by monitoring the website that the user has visited in the application software that the user has utilized. Claim 1, upon which claim 3 depends, calls for using the collected information. Further, the claim calls for choosing an advertising resource based on a given characteristic of the receiver. The characteristic of the receiver is the subject of the collecting information step. Thus, information is collected about characteristics of the receiver and that is used to choose the advertising resource.

Claim 3 was rejected under § 103 over Picco taken alone. The fact that Picco teaches collecting some statistics according to the examiner, and the fact that it is well know to monitor viewer usage habits at a system does not meet the scope of the claimed invention. The claimed

invention is more specific and the alleged well-known practice fails to meet that limitation. In particular, there is no reason to use any information of the type specifically claimed for the purpose specifically claimed. Therefore the rejection of claim 3 should be reversed.

The rejection of claims 2 and 4-6 should be reversed on the same grounds as set forth in A above, as should claim 10.

C.   Whether claim 33 is unpatentable under 35 U.S.C. § 103(a) over Picco (US 6,029,045) in view of Moshfeghi (US 6,076,166).

Claim 33 is directed to collecting information "about one or more characteristics", as recited in claim 1, by collecting information on hardware and software resident on the system. Plugged back into claim 1, claim 33 requires that information about the hardware and software resident on the system is used to identify which advertisement to play ("...choosing...an advertising resource...based on the given characteristic...").

Nothing in the cited reference to Moshfeghi teaches any such thing. Nothing asserted in the rejection would seem to meet the limitation of collecting a specific information claimed or using it for the claimed purpose, namely to select advertisements.

Therefore the rejection should be reversed.

D.   Whether claim 34 is unpatentable under 35 U.S.C. § 103(a) over Picco (US 6,029,045) in view of Thomas (US 2003/0037068).
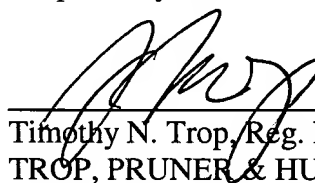
For the reasons set forth in section A above this rejection should be reversed.

*   *   *

Applicant respectfully requests that each of the final rejections be reversed and that the claims subject to this Appeal be allowed to issue.

Respectfully submitted,

Date: November 15, 2007   _____

Timothy N. Trop, Reg. No. 28,994
TROP, PRUNER & HU, P.C.
1616 S. Voss Road, Suite 750
Houston, TX 77057
713/468-8880 [Phone]
713/468-8883 [Fax]

CLAIMS APPENDIX

The claims on appeal are:

1.   A method comprising:

allowing the use of content on a content receiver;

collecting information about one or more characteristics of the receiver;

providing the collected information to a remote processor-based system;

said receiver receiving, from the remote processor-based system, a first subset listing of advertising resources and guidelines for distributing advertising materials on the receiver, said first subset listing of advertising resources selected from a database of advertising resources based on at least one of said one or more characteristics of the receiver;

automatically and selectively choosing, on said receiver and without user intervention, an advertising resource from the first subset listing based on a given characteristic of the receiver to compile a second subset listing of advertising resources, the second subset listing finer tuned to a characteristic of the receiver than said first subset listing; and

capturing an advertisement listed on the second subset listing of advertising resources to store the advertisement on said content receiver.

2.   The method of claim 1 including combining the first subset listing of advertising resources with advertising resources previously available on the receiver and automatically and selectively choosing an advertising resource from said first subset listing or said advertising resources previously available on the receiver to create said second subset listing.

3.   The method of claim 1 wherein collecting information includes monitoring the activities of the user of the receiver including monitoring the web sites that the user has visited and the application software that the user has utilized.

4.   The method of claim 3 wherein collecting information includes developing a database of information about activities undertaken by the user of the receiver.

15

5.   The method of claim 4 wherein receiving the first subset listing of advertising resources includes receiving a first subset listing of advertising resources from a database of advertising resources stored on said remote processor-based system based on information about the user of the receiver.

6.   The method of claim 5 wherein compiling said second subset listing of advertising resources to use to capture advertisements available on a remote processor-based system includes compiling said second subset listing based on the particular patterns of a user of the receiver.

7.   The method of claim 1 including determining a characteristic of advertising and comparing said characteristic to information about the use of the receiver.

8.   The method of claim 1 including storing a variety of content on the content receiver to select for play at any time.

9.   The method of claim 1 including automatically replacing the content, other than advertising with advertising after allowing the content to be used for a predetermined amount of time.

10.   The method of claim 1 including controlling the number of times a user may access content other than advertising that is stored on the receiver.

11.   An article comprising a medium for storing instructions that enable a receiver to:
        allow the use of content on the receiver;
        in response to detecting a pause in content usage, automatically interrupt the use of the content, the place in the content where the pause occurs, if said pause occurs at all, not predetermined;
        while said content usage is paused, enable the receiver to temporarily replace the content with advertising;
        collect information about characteristics of the receiver;

provide the information to a remote processor-based system;

receive, from said remote processor-based system, a subset listing of advertising resources and guidelines for using advertising materials in connection with the receiver, said subset listing selected from a database of advertising resources;

selectively choose, without user intervention, an advertising resource from the subset listing based on a characteristic of the receiver; and

capture an advertisement corresponding to the chosen advertising resource to store the advertisement on said content receiver.

12. The article of claim 11 further storing instructions that enable the receiver to store a variety of content on the receiver to select for play at any time.

13. The article of claim 11 further storing instructions that enable the receiver to monitor the activities of the user of the receiver.

14. The article of claim 13 further storing instructions that enable the receiver to develop a database of information about activities undertaken by the user of the receiver.

15. The article of claim 14 further storing instructions that enable the receiver to select advertisements stored on the remote processor-based system based on information about the user of the receiver.

16. The article of claim 15 further storing instructions that enable the receiver to compile a local electronic guide to advertising resources other than said subset listing to use to capture advertising available on a remote processor-based system.

17. The article of claim of 11 further storing instructions that enable the receiver to determine a characteristic of advertising and compare the characteristic to information about the use of the receiver.

18.   The article of claim 11 further storing instructions that enable the receiver to automatically replace content with advertising after allowing content to be used for a predetermined amount of time.

19.   The article of claim 11 further storing instructions that enable the receiver to automatically determine at predetermined times whether to replace said content.

20.   The article of claim 11 further storing instructions that enable the receiver to automatically compile a receiver-based database of advertising resources, said receiver-based database including a subset of selections from said subset listing.

21.   A system comprising:

a receiver that receives the transmission of content, said receiver including a shell to enable the use of content to be paused and temporarily replaced with a previously stored advertising, said pause in the use of content initiated by a user at random; and

storage coupled to said receiver storing instructions that enable said receiver to determine information about a characteristic of the receiver, receive, from a remote processor-based system, a first subset listing of advertising resources and guidelines for distributing advertising materials on the receiver, the first subset listing based on the information about the receiver, use the information to automatically and selectively choose a subset of advertising resources from the first subset listing, and capture the advertisements corresponding to the subset of advertising resources to store the advertisements on the receiver.

22.   The system of claim 21 wherein said system is a television receiver.

23.   The storage of claim 21 wherein said receiver automatically replaces the content with advertising after allowing content to be used for a predetermined amount of time.

24.   The system of claim 21 wherein said receiver automatically determines at predetermined times whether to replace the content with advertising.

25.   The system of claim 21 wherein the receiver enables a variety of content to be selected for play at any time.

26.   The system of claim 21 wherein said storage stores instructions that enable the receiver to monitor the activities of the user of the receiver.

27.   The system of claim 26 wherein said storage stores instructions that enable the receiver to develop a database of information about activities undertaken by the user of the receiver.

28.   The system of claim 21 wherein said storage stores instructions that enable the receiver to access a database of available advertisements on a remote processor-based system.

30.   The system of claim 21 wherein said storage stores instructions that enable the receiver to compile a local electronic guide to advertising resources to use to capture advertisements available on the remote processor-based system, said local electronic guide to advertising resources compiled without user intervention and including a second subset listing of advertising resources that is based on an activity of the user of the receiver to create a subset listing that is finer tuned than said first subset listing.

31.   The system of claim 21 wherein said storage stores instructions that enable the receiver to access a database of available advertisements on a specialized, remote processor-based system.

32.   The system of claim 31 wherein said storage stores instructions that enable the receiver to access a database of available advertisements on a remote processor-based system specialized for a language other than the national language spoken in the location of said receiver.

33.   The method of claim 1 wherein collecting information includes collecting information about a characteristic of at least one of the hardware and software that is present on the receiver.

34.   The method of claim 1 including detecting a user-initiated pause in content usage and in response to detecting a pause in content usage, automatically interrupting the use of the content to temporarily replace the content with a previously stored advertisement, the place in the content where said pause occurs, if said pause occurs at all, not determined by a content provider.

EVIDENCE APPENDIX

None.

RELATED PROCEEDINGS APPENDIX

None.